

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q90347

Toyohisa FUJIMOTO

Appln. No.: 10/552,036

Group Art Unit: 1712

Confirmation No.: 6985

Examiner: Marc S. Zimmer

Filed: October 3, 2005

For: CURABLE COMPOSITION

REQUEST FOR REFUND

MAIL STOP 16

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Sir:

Applicant hereby respectfully requests a refund in the amount of \$520.00. This refund is to be credited to Deposit Account No. 19-4880.


On November 20, 2007, applicant filed a Response to Election of Species Requirement dated August 20, 2007. While this would normally be a 1-month or 30-day action, in this case the Office Action was designated as a 3-month action. Thus, applicant's response was timely filed. However, applicant was charged a two-month extension of time fee in the amount of \$460.00, plus an additional \$60.00 for a total of \$520.00. Applicant is at a loss as to why the additional \$60.00 fee was charged.

REQUEST FOR REFUND
U.S. Appln. No.: 10/552,036

Attorney Docket No.: Q90347

A copy of the Deposit Account Monthly Statement showing the charge to our account, a copy of the USPTO Sales Receipt showing a \$520.00 extension of time fee, and a copy of the August 20, 2007 Office Action are attached.

Respectfully submitted,


Sheldon I. Landsman
Registration No. 25,430

SUGHRUE MION, PLLC
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Account No.	194880
Date	12-31-07
Page	88

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12	27	07	106	77359454	200671/S12692	7001	325.00	180274.75
12	27	07	151	11993900	Q105813	1631	310.00	179964.75
12	27	07	152	11993900	Q105813	1642	410.00	179554.75
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,036	10/03/2005	Toyohisa Fujimoto	Q90347	6985

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
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WASHINGTON, DC 20037

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AUG 21 2007

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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08/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,036

Applicant(s)

FUJIMOTO, TOYOHISA

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This application contains claims directed to the following patentably distinct species:

Claims 1-3 are directed to a composition comprising as one of the essential components a silyl group-functionalized polyether (A) having a different structure that depends on the precursors from which it is derived. For instance, claim 4 contemplates that (A) is prepared by hydrosilylation of a polyether derivatized with alkenyl groups with an organosilicon compound bearing Si-H residues. Claim 5 discloses a polymer (A) derived from a hydroxyl group-containing polyether and an organosilicon compound bearing an isocyanate group. (Ostensibly, the isocyanate group is not bonded directly to the silicon atom but the claim does not exclude this possibility.) Claim 6 requires (A) to be formed by reacting a polyether featuring isocyanate-terminal groups and an organosilicon compound bearing amine groups. Finally, claim 7 stipulates that (A) is prepared by reacting a polyether bearing alkenyl moieties with an organosilicon compound containing mercapto groups.

Claims 8-11 and 12-15 further limit claims 2 and 3 respectively in precisely the same fashion as claims 4-7 further limit claim 1. The polymer delineated in claims 4, 8, and 12 represent one species, that in claims 5, 9, and 13 a second species, that in claims 6, 10, and 14 a third species, and that in claims 7, 11, and 15 a fourth species. Each species has different structural attributes, in particular a different organic residue connecting the polyether backbone and the silicon atom by virtue of the different synthetic approaches used to make each embodiment and, hence, would require the

Art Unit: 1712

employment of different search terms, and possibly subclasses, to find the most relevant prior art.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

Art Unit: 1712

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 14, 2007



MARC S. ZIMMER
PRIMARY EXAMINER